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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIANI LYNNE PEARSON and
GRAEME JOHN PROUDLER

Appeal 2009-010225
Application 10/080,479
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Siani Lynne Pearson, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-10 and 12-24. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The invention relates “to the production, design, and maintenance of business forms within a document management system.” Specification 1:5-6.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An apparatus for ascertaining the status of a data processing environment, comprising at least one trusted computing device which is arranged to challenge other devices within a data processing environment, to keep a record of the response and to make the record available.

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Apr. 3, 2006) and Reply Brief (“Reply Br.,” filed Sep. 5, 2006), and the Examiner’s Answer (“Answer,” mailed Jul. 14, 2006).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

England US 6,327,652 B1 Dec. 4, 2001

The following rejection is before us for review:

1. Claims 1-10 and 12-24 are rejected under 35 U.S.C. §102(e) as being anticipated by England.

ISSUE

The major issue is whether England describes, expressly or inherently, a “trusted computing device” (e.g., claim 1).

FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Examiner’s Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

All the claims call for the use of a “trusted computing device”. Accordingly, in order for England to anticipate the claimed subject matter, England must describe a “trusted computing device”, either expressly or inherently.

A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. FN6 First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board’s claim construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed.Cir.1997). Secondly, the Board must compare the construed claim to a

prior art reference and make factual findings that “each and every limitation is found either expressly or inherently in [that] single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed.Cir.1998).

In re Crish, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

The Specification defines the term “trusted” in the context of the claimed invention as “mean[ing] that something can be trusted, in the sense that it is working in the way that it is intended and expected to work and is not or has not been tampered with in order to run malicious operations.” Specification 2:11-13. In light of this definition, the Examiner found England to inherently describe using “trusted” computing devices because the computing environment within which they operate are “authenticated via challenge/response protocol.” (emphasis original) Answer 6.

The Appellants argue that the Examiner has not shown that England’s server can be trusted (Reply Br. 1) and that England is “centered on the trustworthiness of the OS component, not on the trustworthiness of the content provided by the server 220.” (emphasis original) (App. Br. 7).

We do not find that the Examiner’s position is in error. In our view, one of ordinary skill in the art reading England would expect all the computing devices described therein to work in the way that they are intended and expected to work and is not or has not been tampered with in order to run malicious operations. One of ordinary skill in the art reading England would not expect them to work in a way that they are not intended and expected to work and are or have been tampered with in order to run malicious operations. Absent evidence to the contrary, the machines England discloses are presumably necessarily working in the way that they are intended and expected to work and are not or have not been tampered with in order to run malicious operations. Accordingly, we find that the

computing devices England describes are “trusted computing device[s]” as the Appellants have defined them.

After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the Appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985); *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). In that regard, we do not find the Appellants have shown that England’s computing devices fail to be in a “trusted” condition as the Appellants have defined it.

The Appellants further argue that England does not describe a trusted computing device “which is arranged ... to keep a record of the response and to make the record available” (claim 1). App. Br. 8. This is not a persuasive argument. The Appellants focus their attention on England’s server (because that is the specific machine the Examiner relied upon as showing a trusted computing device (*see* Answer 3)) and point out that the server does not keep a record. It is, e.g., kept on a client. App. Br. 8 and Reply Br. 2. However, not only does the claim not require a server to keep a record but it need not keep the record. The claim calls for an *arrangement* whereby the trusted computing device, “keep[s] a record of the response and [makes] the record available.” (App. Br. 8) As long as England describes a trusted computing device “*arranged* ... to keep a record of the response and to make the record available” (claim 1), England anticipates the claimed subject matter. In that regard, the Appellants concede that England teaches keeping a record and making it available. Given that we have found the computing devices England describes are “trusted computing device[s]” as the Appellants have defined them, the computing devices England describes,

including the server, are necessarily and thus inherently “*arranged ... to keep a record of the response and to make the record available*” (claim 1).

The Appellants challenged the rejection of claims 2, 3, and 5-10 for the same reasons as those used to challenge the rejection of claim 1. Since we have found those arguments unpersuasive (*see supra*), we reach the same conclusion as to the rejection of claims 2, 3, and 5-10.

With respect to claim 4, the Appellants argued that the England disclosure the Examiner relied upon (Answer 4) as showing a server arranged to listen to communications within a data processing environment “so as to identify the presence of new devices” (claim 4) in fact only understands where a message is coming from. App. Br. 8-9 and Reply Br. 2-3. The argument is unpersuasive. The Appellants appear to agree that England shows the server arranged to listen to communications within a data processing environment. The Appellants disagree only in that the claimed arrangement listens “so as to identify the presence of new devices” rather than, per England, so as to understand where a message is coming from. But the record contains insufficient evidence of a difference in terms of apparatus elements between device that listens in order to identify the presence of new device and one that listens in order to understand where a message is coming from. Accordingly, the argued-over difference amounts to a difference in intended use for the trusted computing device arrangement. A distinction based on an intended use for an apparatus is patentably inconsequential.

The Appellants separately argued claims 12 and 13 but challenge their rejection for the same reasons as those used to challenge the rejection of claim 1. App. Br. 11. Since we have found those arguments unpersuasive

(*see supra*), we reach the same conclusion as to the rejection of claims 12 and 13.

The Appellants challenged the rejection of claims 14 and 15 on the grounds that England does not teach the trusted computing device arranged to search for a generation identifier “within the challenge.” App. Br. 11. The Examiner took the position that “[c]ounters [as disclosed in England, e.g., col. 12, ll. 44] can be used as part of a challenge as to whether or not a certificate is not valid or untrustworthy.” Answer 5. The difficulty with the Examiner’s position is that the rejection is under §102(e). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). While it is possible that England’s counters can be used as part of a challenge, a trusted computing device arranged to search for a generation identifier “within the challenge” does not necessarily follow from the counter’s presence.

The Appellants separately argued claims 16-18 but challenge their rejection for the same reasons as those used to challenge the rejection of claim 1. App. Br. 13. Since we have found those arguments unpersuasive (*see supra*), we reach the same conclusion as to the rejection of claims 16-18.

The Appellants separately argued claim 19 but challenge their rejection for the same reasons as those used to challenge the rejection of claim 4. App. Br. 14. Since we have found those arguments unpersuasive (*see supra*), we reach the same conclusion as to the rejection of claim 19.

The Appellants separately argued claim 20, challenging its rejection over the England disclosure at column 19, ll. 15-39 and column 10, ll. 14-17. App. Br. 14. *Cf.* Answer 5. We have reviewed the passages but do not see where in these passages the claimed subject matter is expressly or inherently described. There is no mention there of a device generating a challenge that includes a generation identifier such that any device that receives the challenge can examine the generation identifier to establish whether the challenge is directly received from the device or retransmitted as claimed.

The Appellants separately argued claim 21, 23, and 24 but challenge their rejection for the same reasons as those used to challenge the rejection of claim 1. App. Br. 15. Since we have found those arguments unpersuasive (*see supra*), we reach the same conclusion as to the rejection of claim 21.

The Appellants separately argued claim 22, challenging its rejection over the England disclosure at column 9, ll. 52-55 and column 10, ll. 14-17. App. Br. 16. *Cf.* Answer 4. We have reviewed the passages but do not see where in these passages the claimed subject matter is expressly or inherently described. The passages describe a challenge-response process that follows a common protocol. There is no mention there of a “set of security rules” as claimed.

DECISION

The rejection of claims 1-10 and 12, 13, 16-19, 21, 23, and 24 under 35 U.S.C. §102(e) as being anticipated by England is affirmed. The rejection of claims 14, 15, 20, and 22 under 35 U.S.C. §102(e) as being

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anticipated by England is reversed. Accordingly, the decision of the Examiner to reject claims 1-10 and 12-24 is affirmed-in-part

AFFIRMED-IN-PART

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